The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDETAKA OKA, KAZUHIKO KUNIMOTO, HISATOSHI KURA, MASAKI OHWA and JUNICHI TANABE

Appeal No. 2005-1602
Application No. 09/734,635

ON BRIEF

Before GARRIS, KRATZ, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is hereby remanded to the Examiner, via the office of the Director for Technology Center 1700, for action consistent with our comments below.

A pivotal issue on this appeal relates to the Appellants' profferred showing of unexpected results. As evidence of unexpected results, the Appellants refer to the Declaration filed July 19, 2004 under 37 CFR § 1.132 and to the data set forth in Tables 2 and 3 and on pages 61-63 of the subject specification. See pages 5-12 of the brief. The Examiner has responded to the

unexpected results issue in the three sequential paragraphs spanning pages 5-7 of the answer. For the reasons which follow, this response by the Examiner is incomplete.

The most fundamental deficiency of this response is the fact that the Examiner has completely failed to address any aspect at all of the unexpected results discussion on pages 6-12 of the brief concerning the data in Tables 2-3 and on pages 61-63 of the specification. The Examiner's complete failure to address this entire section of the Appellants' unexpected results showing is particularly egregious given that the Examiner regards the above mentioned declaration evidence to be insufficient on the grounds that it is not commensurate in scope with the appealed claims. This failure is even more egregious with respect to dependent claim 5 specifically since the Examiner states that "[a]ppellants have offered no compounds [in their declaration showing of unexpected results] wherein R_1 is a C_2-C_4 alkanoyl as set forth in the instant claim 5" (Answer, page 7). This statement inexcusably ignores the position expressed by the Appellants on pages 11-12 of the brief that the specification data evinces unexpected results for this claim because "[a]ll 30 examples within the present disclosure exemplify R_1 is C_2-C_4 alkanoyl providing support for claim 5" (Brief, page 11).

The Examiner's response to the Appellants' nonobviousness showing is also deficient in a number of other respects.

In support of her earlier mentioned position that the Appellants' showing is not commensurate in scope with the appealed claims, the Examiner states that "[t]he independent claim of the present invention encompasses a vast number of choices" (Answer, page 6). This unembellished statement is not particularly helpful in assessing the merits of the Examiner's position. Therefore, the Examiner should provide the application record with a reasonable estimate of the number of compounds embraced by formula (I) (which are the compounds of interest relative to the applied Laridon reference) of appealed independent claim 1.

Additionally, in the first full paragraph on page 6 of the answer, the Examiner contends that the photopolymerization system used in the declaration showing is inadequate to provide a proper comparison between the prior art compounds of the applied Laridon reference and the inventive compounds of the appealed claims. According to the Examiner, "[a] better comparison would have been to make the [photopolymerization] composition of example 1 of Laridon and substitute the taught ketoxime component for the inventive aldoxime component" (Answer, page 6). However,

the Examiner has not explained why this comparison would be "better." More significantly, the answer contains no rebuttal at all to the Appellants' explanation of why they believe the photopolymerization system of the declaration is appropriate (see the paragraph bridging pages 7 and 8 of the brief).

Further, the Examiner has criticized the declaration showing vis-à-vis the inventive compound used in the proffered comparison. It is the Examiner's belief that "a closer comparison would have been to use a C_{6-20} aryl, which is substituted by a C_{1-20} alkyl group or a halogen group" (Answer, page 6). Again, the Examiner has not explained why she believes such compounds would have been "a closer comparison" (id.). Further, the Examiner once more has not offered a rebuttal to the Appellants' explanation of why they believe the inventive compounds of the declaration comparison were properly chosen (see the section on page 7 of the brief entitled "Choice of Compounds B1 and B2 from Instant Application").

Finally, it is unclear whether the Examiner considers the declaration comparison to involve the closest prior art compound exemplified or specifically taught by Laridon. If so, the Examiner should provide the written record with a statement of such. If not, the Examiner should provide the written record

with an explanation of why one of Laridon's other specifically disclosed compounds would be more appropriate as well as a rebuttal of the Appellants' contrary view expressed in the brief (see the section on page 7 entitled "Choice of Compound A of Cited Prior Art").

Any response to this remand by the Examiner or by the Appellants which involves pursuit of the subject appeal must comply with our current regulations at 37 CFR § 41.30 et seq. (September 13, 2004).

This application, by virtue of its "special" status, requires an immediate action; see the Manual of Patent Examining Procedure § 708.01(D)(8th Edition, Rev. 2, May 2004). It is important that the Board be promptly informed of any action affecting the appeal in this case.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REMAND

BRADLEY R. GARRIS)
Administrative Patent Judge)
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PETER F. KRATZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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